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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,758	04/16/2004	Barry Victor Lloyd Potter	674519-2030	8512
20999	7590	02/10/2005	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			AULAKH, CHARANJIT	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/825,758	Applicant(s) POTTER ET AL.	
	Examiner Charanjit S. Aulakh	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Claims 1-41 are pending in the application.

Specification

2. The disclosure is objected to because of the following informalities: The brief description of drawings is missing in the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 26, 27, 30 and 38-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The following eight different factors (see *Ex parte Foreman*, 230 USPQ at 547; *Wands*, In re, 858 F. 2d 731, 8 USPQ 2d 1400, Fed. Cir. 1988) must be considered in order for the specification to be enabling for what is being claimed: Quantity of experimentation necessary, the amount of direction or guidance provided, presence or absence of working examples, the nature of the invention, the state of the prior art, the relative skill of those in the art, the predictability or unpredictability and the breadth of claims. In the instant case, the specification is not enabling based on at least four of the above mentioned eight different factors such as quantity of experimentation

Art Unit: 1625

necessary, the amount of direction or guidance provided, presence of working examples, the state of the prior art and the breadth of claims.

The instant compounds are inhibitors of steroid sulphatase activity and therefore, will have utility in treating only those disease conditions where inhibitors of steroid sulphatase activity are well known in the prior art to have therapeutic effect such as breast cancer. There is no teaching in the specification or prior art reference provided showing well known utility of the inhibitors of steroid sulphatase activity in all known disease conditions associated with STS activity. There is no teaching in the specification regarding association of either increased or decreased activity of STS activity with any disease condition. The applicants mention selecting compounds capable of modulating STS activity. Do the instant compounds act as agonists or antagonists for STS activity. The utility of instant compounds will be different based on agonist versus antagonist STS activity. There are no working examples present showing efficacy of instant compounds in known animal models of all disease conditions associated with either an increased or decreased STS activity. The instant compounds of formula I encompasses several thousands of compounds based on the values of variables R1 and G and therefore, in absence of such teachings, guidance and presence of working examples, it would require undue experimentation to demonstrate the effectiveness of instant compounds in known animal models of all disease conditions associated with either an increased or decreased STS activity and hence their utility for treating these disease conditions.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1625

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-41 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-4, the position of attachment of variable R1 is not defined. It is not clear which ring of the tetracyclic ring is it attached to? Can it be attached to nitrogen atom of the N-containing ring also?

In claims 1, 3, 5 and 7, the size of the N-containing ring is not defined. There is no mention of this ring besides a 6-membered ring in the specification.

In claims 1-8, the value of variable G defined as ---a substituent ---- is indefinite since these substituents are not defined.

Claims 3-8 and 23 recite the limitation "unsaturated 6-memebered carbocyclic ring" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

In claims 10-17, the term---G or the hydrocarbyl group---- is vague and confusing since variable G is a hydrocarbyl group according to claim 9.

Regarding claim12, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

Note the explanation given by the Board of Patent Appeals and Interferences in *Ex*

Art Unit: 1625

parte Wu, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 12-15 and 17 recite the broad recitation C1-C10 alkyl group, C1-C10 haloalkyl group, (CH₂)₁₋₁₀ aryl, phenyl, phenyl-C1-10 alkyl, cycloalkyl and C1-C10 alkene group, and the claim also recites C1-C6 alkyl group, C1-C6 haloalkyl group, (CH₂)₁₋₅ phenyl etc. which is the narrower statement of the range/limitation.

In claims 20 and 23, last two lines, the term -----wherein the or each alkyl or cycloalkyl or alkenyl or optionally contain one or more heteroatoms or groups---is vague and indefinite since its meaning is not clear.

Claim 29 is substantially a duplicate of claim 28.

In claim 30, the term --modulating STS activity---- is indefinite since it is not clear whether the activity is being inhibited or stimulated ?

Claims 25-29, 34, 35 and 38-41 provide for the use of a compound, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it

Art Unit: 1625

merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 25-29, 34, 35 and 38-41 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Allowable Subject Matter

9. The following is a statement of reasons for the indication of allowable subject matter:

The instant compounds of formula II are allowable over the prior art since they are neither disclosed nor obvious over the prior art. In the art, Potter (WO 02/32409, cited on applicants form 1449) discloses compounds for inhibiting STS activity. The compounds disclosed on pages 17 (last two compounds) and 18 by Potter do anticipate the instant compounds. However, this is inventors own priority document and is not a prior art reference.

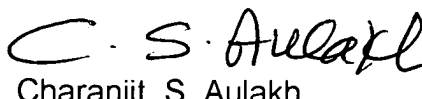
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is

Art Unit: 1625

(571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charanjit S. Aulakh
Primary Examiner
Art Unit 1625